

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 51-63 are pending. Applicant's amendments and remarks after Final are appropriate under 37 C.F.R. §1.116 because they address the Office's remarks in the Final Action.

Declarations under 37 C.F.R. §1.131

Applicant submits herewith two Declarations under 37 C.F.R. §1.131, a Disclosure Document (one page) dated August 29, 1995, an invention disclosure Meeting Record (three pages) dated February 7, 1996, and an email communication (one page) dated April 2, 1996. The invention of the subject application was reduced to practice when the parent application 08/703,487 was filed August 26, 1996.

The Disclosure Document (one page) dated August 29, 1995 evidences that the invention of the subject application was conceived in the United States prior to January 16, 1996, the earliest of the filing dates of U.S. Patent No. 5,732,078 to Arango (hereinafter, "Arango"), and U.S. Patent No. 5,790,935 to Payton (hereinafter, "Payton). The Disclosure Document includes both inventors, Greg Burns and Paul Leach, and describes that "the data transfer rate between the POP and the Internet server is constrained by the bandwidth available".

The invention disclosure Meeting Record (three pages) dated February 7, 1996 evidences an invention disclosure meeting conducted with Applicant's attorney and at least one of the inventors of the subject application, Greg Burns. Similar to the Disclosure Document, the Meeting Record also describes that "[w]ith many POPs requesting data from a popular web server, the link between that server and the

1 Internet may approach/exceed its bandwidth capacity.” Additionally, the Meeting
2 Record describes an implementation of the invention that “will provide a separate
3 broadcast channel (e.g., satellite) between the web server and the POP server,
4 allowing the web server to simultaneously provide data to a large number of POP
5 servers relatively free of bandwidth problems.”

6 The email communication (one page) dated April 2, 1996 evidences that a
7 first draft of the parent application, identified as Attorney’s Docket No. MS1-095US,
8 was completed by April 2, 1996. As described above, the parent application
9 08/703,487 was then filed August 26, 1996.

10 A first Declaration under 37 C.F.R. §1.131 is signed by one of the two
11 inventors: Paul Leach. The signature of the signing inventor is sufficient (*MPEP*
12 §715.04). The Declaration states that the claimed subject matter was conceived in
13 the United States prior to January 16, 1996, the earliest of the filing dates of Arango
14 and Payton.

15 The first Declaration also states reasonable diligence to reduce the
16 invention to practice from just prior the filing date of Arango on January 16, 1996
17 up to the filing date of the parent application 08/703,487 on August 26, 1996.
18 Diligence is judged on the basis of the particular facts in each case (*MPEP*
19 §715.07(a)). Further, reasonable diligence does not require that an inventor or his
20 attorney drop all other work and concentrate on the particular invention involved
21 (*MPEP* §2138.06), nor does reasonable diligence require a party to work
22 constantly on the invention (*Bey v. Kollonitsch*, 866 F.2d 1024, 1028, 231 USPQ
23 967, 970 (Fed. Cir. 1986)).

24 A second Declaration under 37 C.F.R. §1.131 is signed by an Applicant
25 representative and also states evidence of reasonable diligence from just prior the

1 filing date of Arango on January 16, 1996 up to the date of the invention disclosure
2 meeting conducted with Applicant's attorney on February 7, 1996. For example,
3 Applicant's patent procurement process is an on-going process of activity that
4 includes receiving the Disclosure Document from the inventor(s), reviewing the
5 Disclosure Document for completeness, importance level, and patentability by way
6 of meetings and discussions, assigning outside counsel to review and conflict check
7 the Disclosure Document, receiving confirmation from the outside counsel by way
8 of a disclosure meeting request, and coordinating the disclosure meeting between the
9 outside counsel representative and the inventor(s). This patent procurement process
10 is evidence of reasonable diligence from "just prior to the entry in the field of the
11 party who was first to reduce to practice (i.e., Arango on January 16, 1996) and...
12 until the first conceiver reduces to practice (i.e., Applicant on August 26, 1996)"
13 (*MPEP* §2138.06).

14 Accordingly, the Applicant (e.g., any one or more of the inventors,
15 Assignee, and staff) and/or Attorney (e.g., attorney(s) and clerical staff) exercised
16 reasonable diligence to schedule and conduct the invention disclosure meeting on
17 February 7, 1996 after the Disclosure Document was prepared on or about August
18 29, 1995. Further, the Attorney was reasonably diligent to prepare (e.g., write,
19 revise, review, etc.) the first draft of the parent application by April 2, 1996, and the
20 Applicant and/or Attorney were reasonably diligent to review, revise, and prepare
21 the final draft of the parent application, along with the formal filing documents, and
22 file the parent application 08/703,487 on August 26, 1996.

23 The invention of the subject application was conceived in the United States
24 prior to January 16, 1996, the earliest of the filing dates of Arango and Payton, and
25 Applicant and Attorney exercised reasonable diligence to disclose, prepare, and file

1 the parent application. Accordingly, the Arango and Payton references should be
2 removed as references because they are not prior art.

3
4 **35 U.S.C. §103 Claim Rejections**

5 Claims 51-63 are rejected under 35 U.S.C. §103(a) for obviousness over
6 U.S. Patent No. 5,790,935 to Payton (hereinafter, "Payton"), in view of U.S. Patent
7 No. 5,732,078 to Arango (hereinafter, "Arango") (*Office Action* p.2). Applicant
8 respectfully requests that the §103 rejection be withdrawn because Payton and
9 Arango are removed as prior art references as described above.

10
11 **Conclusion**

12 Pending claims 51-63 are in condition for allowance. Applicant
13 respectfully requests reconsideration and issuance of the subject application. If
14 any issues remain that preclude issuance of this application, the Examiner is urged
15 to contact the undersigned attorney before issuing a subsequent Action.

16
17 Respectfully Submitted,

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19 Dated: Jan 7, 2004

20 By: 

21 David A. Morasch
22 Reg. No. 42,905
23 (509) 324-9256 x 210
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